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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: ALEXANDER STEINKOGLER

SERIAL NO.: 09/718,473

FILED: May 14, 2001

GROUP ART UNIT: 2876

EXAMINER: Kimberly D.  
NGUYEN

ATTY. REFERENCE: STEI3004/JEK/JJC

FOR: METHOD FOR PROCESSING SHEET MATERIAL

COMMISSIONER FOR PATENTS

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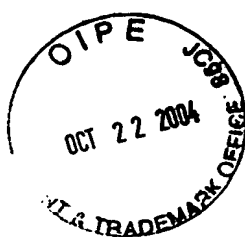
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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**In re Application of:**

**Inventor:** Alexander STEINKOGLER **Application No.:** 09/718,473  
et al. **Confirmation No:** 3550

**Filed:** May 14, 2001 **Attorney No.:** STEI3004/JEK/JJC  
**Customer No.:** 23364

**Examiner:** Kimberly D. NGUYEN **Art Unit:** 2876

**For:** METHOD FOR PROCESSING SHEET MATERIAL

**APPEAL BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This appeal brief is filed pursuant to the applicants' appeal to the Board of Patent Appeals and Interferences from the final rejection of claim in the above-application.

**I. REAL PARTY OF INTEREST**

The real party in interest is the assignee of record: Giesecke & Devrient GmbH (Munich, GERMANY).

**II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### **III. STATUS OF CLAIMS**

Claims 1-15 are currently pending in the above-referenced application and each claim presently stands rejected.

Applicants appeal from the rejection of only claims 1 and 7. Claims 2-6 and 11-13 depend from claim 1. Claims 8-10 and 14-15 depend from claim 7. These claims have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,064,222 ("Legault"). A copy of appealed claims 1 and 7 are included in the attached Appendix I.

### **IV. STATUS OF AMENDMENTS**

All proposed amendments have been entered and no amendments have been officially proposed since the mailing of the rejection in the office action dated June 14, 2004.

### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

A problem to solved by the present invention is to provide a method for processing sheet material by which different groups of sheet material are processed successively with a bank note processing machine (page 2, lines 3-10). Variations of the present invention are recited in independent claims 1 and 7.

#### **A. Claim 1**

In a variation of the present invention, a method is provided in claim 1 for successively processing groups of loose sheet material (page 3, lines 27-30; FIGS. 2-4). The method comprises separating the different groups of sheet material (page 3, lines 20-21; page 6, lines 3-7) and processing the separate groups of sheet material (page 4, lines 3-9). The step of processing sheet material includes examining the fitness or obtaining information of loose sheet material of each group of sheet material in a bank note processing machine (page 2, lines 25-27; page 3, line 23 through page 4, line 17).

The method is distinguished by employing a separator card for separating the different groups of sheet material (page 3, lines 21-22; page 4, 18-24; FIGS. 2-4). At

least one information carrier is used for processing the different groups of sheet material (page 4, lines 5-9; FIGS. 2-4). The at least one information carrier bears information specific to a group of sheet material (page 2, lines 16-18; page 6, lines 8-17; FIGS. 2-4). The separator card and the information carrier are separate entities (page 7, lines 12-18; FIGS. 2-4).

B. Claim 7

In another variation of the present invention, a means is provided for separating and successively processing different groups of loose sheet material transported in a sheet processing device is recited by claim 7.

The means is defined by at least one separator card that is arranged to provide an indication of a separate group of loose sheet material (page 3, lines 21-22; page 4, 18-24; FIGS. 2-4). The separator card enables the groups of sheet material to be successively transported in a sheet processing device (page 3, line 25 through page 4, line 17).

The means is also defined by at least one information carrier that provides specific information concerning a group of loose sheet material (page 2, lines 16-18; page 4, lines 5-9; page 6, lines 8-17; FIGS. 2-4).

The at least one separator card and the at least one information carrier are separate from one another (page 7, lines 12-18; FIGS. 2-4).

**6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,064,222 (Legault).

**7. ARGUMENT**

A. Overview

The Legault patent fails to disclose or suggest each every feature, whether expressly or inherently, recited in either of claims 1 and 7. Moreover, one skilled in

the art would not reasonably understand or infer from the Legault patent each of the limitations of claims 1 and 7.

Accordingly, the Legault patent does not anticipate claims 1 and 7 of the present application.

Due to the similarity in subject matter of claims 1 and 7, in which inventive features of the present invention are positively recited, the following arguments for the patentability of claims 1 and 7 in view of the Legault patent will be treated together.

## B. Pertinent Law

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. *See, for example, In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994); and *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior art reference's teaching that every claim limitation was described in that single reference. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801, 1809 (Fed. Cir. 2003). To establish anticipation, it must be shown that a single prior art reference describes each and every limitation of a claimed invention. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986); cert. denied, 480 U.S. 947 (1987). The description in the reference may be either express or inherent. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In order for a reference to serve as an anticipatory reference when such reference is silent about an asserted inherent characteristic, the gap in the teachings of the reference may be filled with recourse to extrinsic evidence. It will be noted, however that evidence must make clear that the missing descriptive matter is

necessarily present in the thing described in the reference. *Cont'l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.Cir.1991).

C. The Subject Matter Recited in Claims 1 and 7 is Not Anticipated by the Legault Patent

1. Basic Description of the Legault Patent

The Legault patent is directed to a device for applying a bar code to the face of an envelope to designate individual letters or numbers of a postal code that are readable by an optical character reader ("OCR") (column 1, lines 4-8). The device is arranged with groups of sheets that are each intended to be utilized for a single envelope (column 3, lines 1-5).

According to the embodiment described in the patent and shown in FIG. 2, the device is a booklet having a series of groups of sheets wherein each group comprises: a protective cover sheet 3, a stamp page 4, an instruction sheet 7, and a bar code applicator 8 (column 2, lines 1-15).

In each group of sheets, the protective cover is described as colored tissue paper which separates the group (column 2, lines 4-5). As shown in FIG. 3, the stamp page amounts to a self-stick adhesive sheet having a postage stamp 20 and a bar code 21 printed thereon (column 2, lines 16-23). The instruction sheet is merely described as instructing a user the method of using the stamp page and the bar code applicator (column 2, lines 13-14).

Turning to the bar code applicator, this is a flexible clear or translucent sheet including arrays of pressure sensitive figures representing numbers and letters (denoted by reference numerals 12 - 16 in FIG. 4) that may be used to mark a postal code onto an envelope in the form of a bar code (column 2, lines 24-49). The bar code applicator also provides a plurality of boxes 11 for a user to hand write a postal code therein corresponding to the bar code (column 2, lines 50-53). When preparing an envelope, a user aligns an envelope with indicia on the bar code applicator so as to permit the user to rub off some of the pressure sensitive bars to form the desired postal code (column 2, lines 59-64).

The bar code applicator is configured to have a sufficient array of pressure sensitive bars to enable a user to form any one of the six figure alphanumeric codes of the Canadian postal code (column 2, lines 28-32).

2. Differences in the Teachings of the Legault Patent from the Claimed Invention Recited in Claims 1 and 7

In the discussion that follows, the applicants submit that the method and means of claim 1 and 7, respectively, differ from the teachings of the Legault patent on the basis of the following particulars:

a. the Legault patent fails to disclose the separation and processing of loose sheet material;

b. the Legault patent fails to disclose or suggest an information carrier bearing information specific to a group of sheet material;

c. the Legault patent fails to disclose or suggest that processing of sheet material includes examining fitness or obtaining information of loose sheet material (in reference to claim 1 only); and

d. the nature of the cover sheet and the bar code applicator in the Legault patent would not be understood by a skilled artisan as a separator card or information means for a bank note processing machine (in reference to claim 7 only).

a. Separation and Processing of Loose Sheet Material  
According to Claims 1 and 7

One of ordinary skill would not reasonably understand or infer from the teachings of the Legault patent that every claim limitation of claims 1 and 7 is described or shown therein. As mentioned above, the Legault patent discloses a bound booklet that is used to provide a stamp and a bar code for an envelope. While it is true that the sheets in the booklet are separated by cover sheets, there is simply no disclosure or suggestion in the Legault patent of processing loose sheet material.

In the outstanding office action, the examiner erroneously refers partly to FIGS. 1 and 2 showing the sheet material of the booklet in support of the allegation that indeed the Legault patent discloses processing "loose sheet material." FIGS. 1 and 2 do not show loose sheet material. To the contrary, FIG. 1 shows a spine 2 which is defined in the Legault patent as being a glue layer that allows the sheets of the booklet to be readily removed (column 1, lines 65-67).

The examiner also proffers column 5, lines 1-5 in support of the notion that the Legault patent describes processing loose sheet material. It is not understood how this passage of the patent can be construed to impart a teaching of processing loose sheet material. This passage merely describes the stamp sheet and applicator as being used for a single envelope. There is nothing to suggest the processing of loose sheet material in this passage.

Conversely to the examiner's interpretation, it appears from the Legault patent that the sheets from each group are removed from the booklet once they have been used for a single envelope since they are no longer useful for providing a stamp and the full spectrum of postal codes (column 2, lines 65-67). Hence, there is no processing of loose sheet material since the sheets are likely only loose from the booklet when they are discarded.

As a consequence of these observations, it is readily apparent that the Legault patent fails to disclose or suggest the separation and processing of loose sheet material.

b. Information Carrier Bearing Specific Information  
According to Claims 1 and 7

The Legault patent fails to disclose or suggest the at least one information carrier of claims 1 and 7. While in the outstanding office action the examiner equates the bar code applicator of the Legault patent as a teaching of an information carrier of the type recited in claims 1 and 7, the bar code applicator does not contain any specific information. Instead it is left for the user to transfer the pressure sensitive numbers and letters from the bar code applicator to an envelope.



It is readily clear from the Legault patent that the bar code applicator does not provide information for a particular group of sheet material. This assertion is reinforced by the description in the Legault patent indicating that the bar code applicator is provided for any six figure Canadian alphanumeric postal code (column 2, lines 28-32). The bar code applicator is merely a template by which a user can transfer a combination of the letters and numbers represented thereon onto an envelope at the user's selection. By its very nature, the bar code applicator lacks specific information regarding a group of sheet material, since it is arranged to impart any one of the Canadian postal codes.

Thus, the bar code applicator does not provide any information specific to a corresponding group of sheet material (i.e., the cover sheet, stamp page, instruction sheet and the bar code applicator itself).

In rebutting the applicants arguments in the outstanding office action, the examiner erroneously asserts that the bar code applicator bears specific information. More specifically, the examiner submits that the "bar code applicator is adapted to allow the user to apply a precise and uniform bar code designating a postal code to the face of an envelope, wherein the bar-code-postal code serves as the information carrier for each group of sheet material." This argument seems to miss the point of the Legault patent which provides a bar code applicator that can be used for any one of the Canadian postal codes. According to the examiner's interpretation, the bar code applicators would lose their function if they were tied to any one postal code.

A proper interpretation of the Legault patent results in each group of sheet material being indistinguishable so as to allow a user to imprint a single envelope with any one of the Canadian postal codes. Information may be transferred from the bar code applicators, however the groups of sheet material are by no means processed or organized on the basis of the information transferred to an envelope. If anything, the envelope only bears information specific to the address of the receiver of the envelope. The envelope, however does not form a part of the groups of sheet material and there is no suggestion in the Legault patent to base such an assertion.

In view of these comments, it is clear that the examiner has erroneously interpreted and misplaced the teachings of the Legault patent against the feature of the information carrier according to claims 1 and 7.

c. Processing of Sheet Material Including Examining the Fitness or Obtaining Information of Loose Sheet Material According to Claim 1

The Legault patent fails to disclose or suggest that processing sheet material includes examining the fitness or obtaining information of loose sheet material in accordance with claim 1. The examiner proposes that the Legault patent teaches this feature of claim 1 in column 2, lines 1-23, however the section provided by the examiner lacks any description of processing sheet material that includes examining the fitness or obtaining information of loose sheet material. Instead, the description relates describing the different sheets in each group of sheet material in the Legault patent.

The identified passage in the Legault patent is simply bereft of any explanation of the actions that are involved with processing sheet material. The remainder of the Legault patent is not helpful either in that it too lacks any such explanation or disclosure.

The examiner has clearly failed to provide sufficient evidence to support the assertion that the Legault patent sufficiently discloses that processing sheet material includes examining the fitness or obtaining information of loose sheet material in accordance with claim 1.

d. Nature of Separator Card and Information Carrier According to Claim 7

One of ordinary skill would not reasonably understand or infer from the teachings of the Legault patent the separator card and information carrier for use in a sheet processing device in accordance with claim 7.

The protective cover sheet in the Legault patent comprises color tissue paper and was equated by the examiner in the action as the separator card of claim 7.

One skilled in the art would likely consider tissue paper inappropriate for use in a sheet processing device as it would likely not be able to withstand the treatment of the device. Moreover, the bar code applicator of the Legault patent was equated as the information carrier in claim 7. Not only does the bar code applicator lack any specific information for a group of sheet material, the bar code applicator comprises a flexible clear or translucent sheet with the pressure sensitive figures (column 2, lines 24-28). One skilled in the art would consider a plastic sheet with pressure sensitive figures inappropriate for use in a sheet processing device since it bears no specific information and the pressure sensitive figures would probably wear onto components of the device.

A skilled artisan would understand from the Legault patent that the protective cover sheet and the bar code applicator, as described in the Legault patent, are wholly inadequate as the separator card and information carrier of claim 7. This claim distinctly recites transporting loose sheet material in a sheet processing device, and the separator card and the information carrier are defined as being arranged to be successively transported in a sheet processing machine.

Hence a skilled artisan would not infer from the Legault patent using a separator card and an information carrier that are structurally sound to permit successive transport in a sheet processing device.

**8. CONCLUSION**

For the reasons set forth above, appended claims 1 and 7 of the pending application define subject matter that is not anticipated within the meaning of 35 U.S.C. § 102(b) over the Legault patent.

The fee required by 37 C.F.R. § 1.17(c) is enclosed herewith.

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Date: October 22, 2004

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written over a horizontal line.

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## APPENDIX OF APPEALED CLAIMS

Claim 1: A method for processing different successively processed groups of loose sheet material, comprising the following method steps:

separating the different groups of sheet material, and

processing the separate groups of sheet material, said step of processing including examining the fitness or obtaining information of loose sheet material of each group of sheet material,

wherein a separator card is used for separating the different groups of sheet material, and at least one information carrier is used for processing the different groups of sheet material and bears information specific to a group of sheet material, the separator card and the at least one information carrier being separate from one another.

Claim 7: Means for separating and processing different groups of loose sheet material transported in a sheet processing device, the means comprising;

at least one separator card arranged to provide an indication of a separate group of loose sheet material as the groups are successively transported in a sheet processing device; and

at least one information carrier arranged to provide specific information concerning a group of loose sheet material as the groups are successively transported in a sheet processing device;

wherein the at least one separator card and the at least one information carrier are separate from one another.